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10/005,846	12/03/2001	Khuy V. Nguyen	2000.83	1022

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EXAMINER

CHANG, VICTOR S

ART UNIT	PAPER NUMBER
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1771

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Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/005,846
Filing Date: December 03, 2001
Appellant(s): NGUYEN ET AL.

Scott Hanf
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 6/13/2005.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of the Claimed Subject Matter*

The summary of the claimed subject matter contained in the brief is correct.

(6) *Grounds of Rejection to be Reviewed on Appeal*

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) *Prior Art of Record*

JP 10-017694

Kondo, et al.

1-1998

(9) *Grounds of Rejection*

The following ground(s) of rejection are applicable to the appealed claims:

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I. Claims 1-3 and 6-11 are rejected under 35 U.S.C. 102(b) as being anticipated by JP 10-017694 (computer translation).

JP '694 is directed to obtain a microporous polyethylene membrane which can be desirably used as a battery separator. The membrane comprises polyethylene (PE, an aliphatic polyolefin), and may be a blend with at most 30% EPR, etc. (Abstract). JP '694 also expressly teaches that the method for producing the microporous membrane comprises three steps: 1) Forming a starting sheet of polymer/plasticizer blend, 2) Stretching, and the stretching method is not limited, biaxial stretching with tenters (i.e., a dry stretched process) is preferred, 3) Extraction (paragraphs 0016-0019).

Appellants' claimed process is a method that is embodied by a single step, that being providing a specific microporous sheet. As JP '694 provides such a sheet, as set forth above, the claims are determined to be anticipated, despite the extra verbiage in the preamble regarding improving mechanical strength of a membrane.

Since JP '694 discloses all the elements as claimed in claims 1-3 and 6-11, they lack novelty.

II. Claims 4 and 5 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 10-017694 (computer translation).

The teachings of JP '694 are again relied upon as set forth above.

It is noted that JP '694 teaches that the microporous membrane is used as a battery separator (abstract), and the instant invention is also directed to membrane to be used as a battery separator (specification, page 4, lines 18-19).

For claims 4 and 5, JP '694 is silent about the Gurley value of the microporous membrane. However, since JP '694 does teach the same subject matter (a microporous membrane) for the same application (a battery separator) as the instant invention, it is the Examiner's position that a suitable Gurley value is either anticipated by JP '694, or obviously provided by practicing the invention of prior art, such that it functions as a battery separator, i.e., in the art of battery separators, lower Gurley values indicate more open micro-structures and are therefore desired.

(11) Response to Argument

With respect to Appellants' argument "The JP 10-017694 reference fails to teach a method of improving the mechanical strength of a membrane ... JP 10-017694 does not suggest that there is any benefit what so ever of adding an elastomer to the polyethylene" (Remarks, page 9), it should be noted that there is no requirement that such alleged benefit be disclosed in the prior art. The prior art was shown to provide the same structure and chemistry as claimed. If some benefit is associated with the addition of elastomer to the PE, it must be inherent to JP '694, since the reference anticipates the combination. Stated another way, the mere recognition of latent properties in the prior art does not render nonobvious an otherwise known invention. MPEP § 2145.II.

Appellants' argument "In claim 9 the clause of the claim, "a dry stretched microporous sheet" is a structural term ... defines the microporous sheet as a particular type of microporous sheet ... The other way to get a microporous sheet would be to use the solvent extraction technique outlined in JP 10-017694. Both methods are

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recognized, in the art, as descriptors of different classes or methods for producing a microporous sheet. See Synthetic Polymer Membranes A Structural Perspective, by Robert Kesting ... where the dry stretched process is described on pages 290-297 and where the solvent extraction by the set process is described on pages 251-261. These pages not only discuss the differences in the two processes but also discuss the physical differences in the end products" (Remarks, pages 10-11, bridging paragraph) has been carefully considered, but is not persuasive. First, the Examiner notes that while the specification of the instant invention describes a process which does not require extraction, nowhere is the phrase "dry stretched" explicitly defined in the specification, nor does Kesting's teaching define the phrase "dry stretched" as a specific process method. It should be noted that although the claims are interpreted in light of the specification, in the absence of an explicit definition, limitations from the specification are not read into the claims. Second, the Examiner repeats that JP '694 does expressly teach a "dry stretched" step prior to solvent extraction, as set forth above, which reads on instant invention as claimed. Third, even if the phrase "dry stretched" is interpreted as structure effecting product-by-process limitation, Appellants

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have failed to provide any evidentiary support that the resultant microporous membranes are structurally distinct from those disclosed by Appellants.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Victor S. Chang

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Examiner
Art Unit 1771

July 15, 2005

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